

REMARKS

In the last Office Action, claims 1, 21, 27 and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No 6,286,216 to Braun. Claims 1, 27 and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,557,699 to Silver. Claims 6, 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Silver in view of U.S. Patent No. 2,155,406 to Warwicker. Claims 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Silver in view of U.S. Patent No. 4,656,744 to Decker. Claims 1, 6, 11-30 and 35-37 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-39 of prior U.S. Patent No. 6,941,605. Additional art was cited of interest.

In accordance with the present response, independent claims 1, 21, 27 and 35 have been amended to incorporate the subject matter of claims 18, 24, 28 and 36, respectively, which have been canceled. Claims 19, 25 and 29 have been amended to depend on claims 1, 21 and 27, respectively, in light of the cancellation of claims 18, 24 and 28. Claims 20, 26, 30 and 37 have been rewritten in independent form to incorporate the subject matter of the corresponding base and intervening claims.

Applicant requests reconsideration of his application in light of the foregoing amendments and the following discussion.

Rejections Under 35 U.S.C. §102(b) and §103(a)

The rejection of independent claims 1, 21, 27 and 35 under 35 U.S.C §102(b) as being anticipated by Braun or Silver have been overcome by virtue of the amendments to these claims.

More specifically, independent claims 1, 21 and 27 have been amended to incorporate the subject matter of claims 18, 24 and 28, respectively, which are directed to a pair of through-holes extending from a first surface of the first portion to a second surface thereof opposite the first surface (claims 1, 27), and a pair of through-holes extending from the first surface to the second surface of the first member and on opposite sides of the longitudinal axis of the first member (claim 21). Claim 35 has been amended to incorporate the subject matter of claim 36 which requires that connecting means comprises a pair of through-holes extending from a first surface of the first portion of the first member to a second surface thereof opposite the first surface, a pair of first fasteners extending through the respective through-holes and engaging the first end portion of the frame member, and a second fastener extending through the second end portion of

the frame member and engaging the piece of material. As recognized by the Examiner, no corresponding structural combination is disclosed or suggested by the teachings of Braun and Silver.

With respect to the rejections under 35 U.S.C. §103(a), claims 6, 11-14 and 17 depend on and contain all of the limitations of amended independent claim 1 and, therefore, distinguish from Braun and Silver at least in the same manner as amended independent claim 1.

Furthermore, while Warwicker has been cited against claims 6, 16 and 17 for its purported teaching of a ruler with a measuring scale and a pencil sharpener, and while Decker has been cited against claims 11-14 for its purported teaching of a marking pencil rest, these references do not cure the deficiencies of Silver with respect to the subject matter of amended independent claim 1, as set forth above, from which claims 6, 11-14, 16 and 17 depend. Accordingly, one of ordinary skill in the art would not have been led to modify the references to attain the claimed subject matter.

In view of the foregoing, applicant respectfully requests that the rejections of claims 1, 21, 27 and 35 under 35 U.S.C. §102(b) based on Braun and Silver and the rejections of claims 6, 11-14, 16 and 17 under 35 U.S.C. §103(a) based on the teachings of Silver, Warwicker and Decker be withdrawn.

Rejection Under 35 U.S.C. §101

Claims 1, 6, 11-30 and 35-37 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-39 of U.S. Patent No. 6,941,605 ("the '605 patent"). Applicant respectfully traverses this rejection.

Independent claims 1, 21, 27 and 35 have been amended to incorporate the subject matter of claims 18, 24, 28 and 36, respectively. Applicant respectfully traverses the Section 101 rejection of claims 18, 24, 28 and 36, now the subject matter of claims 1, 21, 27 and 35, respectively, as claiming the same invention as that of claims 1-39 of the '605 patent.

In determining whether a statutory basis for a double patenting rejection based on claims in an issued patent exists, the claims in the issued patent must claim the same invention as the claims under consideration. "Same invention" means "identical subject matter." In re Vogel, 164 USPQ 619 (CCPA 1970); and In re Ockert, 114 USPQ 330 (CCPA 1957).

In this case, the subject matter of claims 18, 24, 28 and 36, now the subject matter of claims 1, 21, 27 and 35, respectively, is not identical to the subject matter of any of claims 1-39 in the '605 patent.

Amended independent claims 1, 21 and 27 recite a pair of through-holes extending from a first surface of the first portion to a second surface thereof opposite the first surface (claims 1, 27), and a pair of through-holes extending from the first surface to the second surface of the first member and on opposite sides of the longitudinal axis of the first member (claim 21). Amended independent claim 35 recites connecting means comprising a pair of through-holes extending from a first surface of the first portion of the first member to a second surface thereof opposite the first surface, a pair of first fasteners extending through the respective through-holes and engaging the first end portion of the frame member, and a second fastener extending through the second end portion of the frame member and engaging the piece of material. No corresponding "identical" subject matter is recited by any of claims 1-39 in the '605 patent.

Claims 6, 11-17, 19, claims 22, 23, 25, and claim 29 depend on and contain all of the limitations of amended independent claims 1, 21 and 27, respectively, and, therefore, distinguish from the claims in the '605 patent at least in the same manner as claims 1, 21 and 27.

Claims 20, 26, 30 and 37 have been rewritten in independent form to incorporate the subject matter of the corresponding base and intervening claims. These claims are directed to various combinations of the multi-purpose hand tool (claim 20, 30), scribing apparatus (claim 26), and combination (claim 37) and recite that each of the first member and the second member of the multi-purpose hand tool is fabricated from a transparent material. No corresponding "identical" subject matter is recited by any of claims 1-39 of the '605 patent.

In view of the foregoing, applicant respectfully requests that the rejection of claims 1, 6, 11-17, 19, 20-23, 25-27, 29, 30, 35 and 37 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-39 of U.S. Patent No. 6,941,605 be withdrawn.

In view of the foregoing amendments and discussion,
the application is believed to be in allowable form.
Accordingly, favorable reconsideration and allowance of the
claims are most respectfully requested.

Respectfully submitted,

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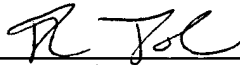
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February 15, 2007

Date